

### Remarks

In the above referenced Final Office Action the Examiner has maintained a rejection under 35 USC 102(b) *while simultaneously acknowledging that the reference does not teach each element of the claims.* In responding to the Applicant's arguments, the Examiner asserts that "omission of an element and its function is obvious if the function of the element is not desired." FOA, Page 2, 2<sup>nd</sup> paragraph under Response to Arguments (Emphasis Added). This is in response to the Examiner acknowledging that the reference teaches a valve member having holes; precluding anticipation of the claim which requires a "coherent plane" (which is defined in the specification to preclude such holes).

Despite acknowledging that the reference does not teach an element of claims and implying an obviousness argument, the Examiner continues to reject certain claims under 35 USC 102(b) and makes this rejection Final.

Applicant respectfully asserts that this is untenable. The rejection under section 102 must be withdrawn along with the finality of the Office Action.

Should the Examiner elect to issue a non-final office action wherein the relevant claims are rejected under 35 USC 103(a), Applicant will address the merits of such a rejection based upon the factual and argumentative support provided by the Examiner. Applicant does not acquiesce to any implied rejection nor to the validity of any such rejection if subsequently presented.

With respect to what the Examiner has stated on the record, Applicant's claims are distinguishable from the art cited. The Examiner states that "the presence of holes 40 [in Boedecker] does not *predict* the device from being capable of projecting a coherent plane." (Emphasis Added). Applicant agrees that the reference does not teach or "predict" a different structure than what is disclosed and certainly does not teach or suggest the claims, including a coherent plane. To the extent the Examiner intended to write that the holes 40 do not preclude the device from being coherent (or some similar language), Applicant must respectfully traverse. In fact, the presence of the holes 40 by definition preclude the device from projecting a coherent plane as articulated in the specification as well as Applicant's previous response, which is incorporated herein by reference.

Despite the Examiner's assertion to the contrary, that a device disclosed in a reference may be *capable* of modification does not suffice to teach or render obvious non-disclosed subject matter under the patent laws and rules of practice. The Examiner makes reference to cases where an undesired element is removed and held to be obvious. This does not relieve the Examiner of the burden to demonstrate that absent Applicant's disclosure and claims this was a known issue, that the ability to remove the element was readily apparent and that there is some teaching, motivation or other objectively established basis to suggest the modification. That someone else *could have invented* a concept earlier most assuredly is not a basis to preclude patentability.

In the instant case, the configuration of the valve (having a coherent plane) is not simply a collection of parts and pieces assembled from a laundry list wherein parts and pieces are substituted without consequence. The reason the prior art teaches valve members having holes (e.g., Boedecker) is because of their necessity or desirability in the manufacturing and /or assembly processes as well as their necessity or desirability in securing such devices to the support structure. That Applicant has identified a problem and a solution that includes a valve with a coherent plane does not abstractly render prior art structures "undesirable" to those of ordinary skill in the art nor does it remotely satisfy the Examiner's burden to establish the same in the context of *examining the claims as a whole*. Furthermore, merely labeling a prior art feature as "undesirable" does not teach or suggest a solution that eliminates the need for such a feature. That is, unlike the cases cited in the Examiner's form paragraph language where the undesirable feature was extraneous (i.e., removed without consequence), the features referred to by the Examiner are functional and integral to the teachings of the reference. Should the Examiner assert otherwise, substantive support must be objectively provided beyond a mere conclusory statement. In other words, even if the Examiner were to provide objective evidence that one would be motivated to modify the teachings of Boedecker – what basis is there (other than Applicant's disclosure) to modify it to include a coherent plane?

Conceptually, the present rejection is roughly equivalent to asserting that the works of Shakespeare would have been obvious (in a literary sense) in view of an empty notebook because nothing precludes one from writing all of the words down in the same order; after all, the English language has a set of "known" words. Alternatively, a large stack of newspapers

could be assembled and selected letters deleted with white out so that what remains reads as a literary masterpiece; in other words, it is easy to assert that particular elements (letters in this case) are undesirable when you are following a roadmap that includes the final product. One could even make a conclusory –and nonsensical- statement to the effect that such a modification or rewriting would be motivated by a desire to save space, or ink or some other generic yet non-supportive reason. Such is the definition of impermissible hindsight.

With respect to claim 5, the Examiner indicates this claim is allowable however, the Office Action Summary indicates claim 5 has been rejected.

The Final Office Action improperly provides a rejection under 35 USC 102(b) while acknowledging that that the reference fails to teach an element of the claims. The Examiner's response implies that Boedecker is being evaluated under 35 USC 103(a). Of course, the relevant claims were not amended and changing the basis of the rejection precludes issuance of a final rejection.

With respect to the substance of the rejection, Applicant respectfully asserts that the references fail to teach a valve having a coherent plane as presented in the various claims. Thus, the pending claims are allowable for the same or similar reasons.

None of the references, alone or in combination, teach or suggest a valve that projects a coherent plane as presently claimed; rather, each reference explicitly teaches and requires holes through the valve for attachment. Likewise, such holes require the removal of material from within the contour of the valve element.

Applicant respectfully asserts that the pending claims are in condition for allowance and respectfully requests notice of the same. Should any issues remain outstanding, the Examiner is urged to telephone the undersigned to expedite prosecution.

Respectfully submitted,  
Kaern et al.,

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